Supreme Court U.S.
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No. 02-487

IN THE

Supreme Court of the United States

JOSEPH A. GENTILUOMO,

Petitioner,

v.

BRUNSWICK BOWLING AND BILLIARDS CORPORATION
(Individually and doing business as Brunswick Technology Ventures)
and as Quantum
and
Columbia 300, Inc.
(Individually and doing business as Track, Inc.)
and Pin Breaker, Inc.,
and
Roto-Grip, Inc.,

Respondents.

On Petition for Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

Supplemental Appendix on Reply Brief On Petition for Writ of Certiorari

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1APP

United States Patent and Trademark Office, "Manual of Patent Examining Procedure" ("MPEP"):

Uniform Application of the Patentability Standard § 706:

> The standards of patentability applied in the examination of claims must be the same throughout the Office. In every art, whether it be considered "complex," "newly developed," "crowded," or "competitive," all of the requirements for patentability (e.g., novelty, usefulness and unobviousness, as provided in 35 U.S.C. 101, 102, and 103) must be met before a claim is allowed. The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture" claim) is never, in itself, justification for allowance of such a claim.
>
> An application should not be allowed, unless and until issues pertinent to patentability have been raised and resolved in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it "strictly adhere" to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. The standard to be applied in all cases is the "preponderance of the evidence" test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable.

§ 706.02 Rejection on Prior Art"

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

§DISTINCTION BETWEEN 35 U.S.C. 102 AND 103

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas. in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. See MPEP §2131 - §2146 for guidance on patentability determinations under 35 U.S.C. 102 and 103.

§ 706.3(a) Rehections under 35 U.S.C. 101

SUBJECT MATTER ELIGIBILITY

Patents are not granted for all new or useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or compositions of matter, or any new and useful improvement thereof."

7.04 Statement of Statutory Basis, 35 U.S.C. 101

35 U.S.C. 101 read as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Examiner Note

This paragraph must precede the first use of 35 U.S.C. 101 in all first actions on the merits and final rejections.

715.07 Facts and Documentary Evidence

GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is

relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:
(A) attached sketches;
(B) . . . .

716.01(a) Objective Evidence of Nonobviousness OBJECTIVE EVIDENCE MUST BE CONSIDERED WHENEVER PRESENT

Affidavits or declarations containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc.* v. *Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, such evidence may have relevancy. *Graham* v. *John Deere Co.*, 383 U.s. 1, 148 USPQ 459 (1966); *In re Palmer*, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). The *Graham* v. *John Deere* pronouncements on the relevancy of commercial success, etc. to a determination of obviousness were not negated in *Sakraida* v. *Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or

Anderson's-Black Rock Inc. v. *Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), where reliance was placed upon *A&P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 87 USPQ 303 (1950). See *Dann* v. *Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n.4 (1976).

716.01(c) Probative Value of Objective Evidence
TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF

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OPINION EVIDENCE

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In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, ans the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc.* v. *Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the *prima facie* case of obviousness); *Ex parte Gray*, 10 USPQ2d 1922 (Bd.Pat.App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a-human b-NGF-like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art

because there was no factual evidence supporting the statement); *In re Carroll,* 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) (expert opinion on what the prior art taught, supported by documentary evidence and formulated prior to the making of the claimed invention, received considerable deference); *In re Beattie,* 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of ta lack of factual support); *Ex parte George,* 21 USPQ2d 1058 (Bd.Pat.App.&Inter. 1991) (conclusory statements that results wer "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

716.01(d) Weighing Objective Evidence

IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WIEGHED AGAINST EVIDENCE SUPPORTING *PRIMA FACIE* CASE

When an applicant submits evidence traversing a rejection, the examiner must reconsider the patentb8lity of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a perponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker,* 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of

patentability does not mandate a conclusion of patentability in and of itself. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a *prima facie* case was reached, not against the conclusion itself. *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the *prima facie* case. All of the competent rebuttal evidence taken as a should be weighed against the evidence supporting the *prima face* case. *In re Piasecki*, 745 F.2d 1468, 1472, 233 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos.* v. *Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989); *Ricahrdson-Vicks, Inc.* v. *The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and pseudoepherdine combination in single table form, while supported by substantial evidence, held not to overcome strong *prima facie* case of obviousness). See *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a detailed discussion of the proper roles

of the examiner's *prima facie* case and applicant's rebuttal evidence in the final determination of obviousness.

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.) See *Demaco Corp.* v. *F. Von Landsdorff Licensing Ltd.*, 851 F.2d 1387, 7USPQ2d 1222 (Fed. Cir.), *cert. denied,* 488 U.S. 956 (1988). See also MPEP §716.10. See MPEP §2144.08, paragraph II.B., for guidance in determining whether rebuttal evidence is sufficient to overcome a *prima facie* case of obviousness.

716.02(a) Evidence Must Show Unexpected Results

. . . . . .

SUPERIORITY OF A PROPERTY SHARED WITH THE PRIOR ART IS EVIDENCE OF NONOBVIOUSNESS

Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut a *prima facie* case of obviousness." . . . .

716.01(b) Burden on Applicant

BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT

The evidence relied up [*sic.*] should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd.Pat.App& Inter. 1992) (Mere conclusions in appellants' brief that the claimed polymer had an unexpected increased impact strength "are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration."); *Ex parte C*, 27 USPQ2d 1492 (Bd.Pat.App& Inter. 1992) (applicant alleged unexpected results with regard to the claimed soybean plant, however, there was no basis for judging the practical significance of data with regard to matruity date, flowering date, flower color, or height of plant.). Se also *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP §716.02(c).

APPLICANTS HAVE BURDEN OF EXPLAINING PROFFERED DATA

'[A]pellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness." *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd.Pat.App.&Inter. 1992).

DIRECT AND INDIRECT COMPARATIVE TESTS ARE PROBATIVE OF NONOBVIOUSNESS

Evidence of unexpected properties may be in the for of direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP §716.02(d) - §716.02(e). See *In re Blondel*, 499 F.2d 1311, 1317, 182 USPQ 294, 298 (CCPA 1974) and *In re Fouche*, 439 F.2d 1237, 1241-42, 169 USPQ 429, 433 (CCPA 1971) for examples of cases where indirect comparative testing was found sufficient to rebut a *prima facie* case of obviousness. . . .

716.02(f) Advantages Disclosed or Inherent

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95) (although the purported advantage of placement of selective catalytic reduction catalyst in the bag retainer of an apparatus for controlling emissions was not disclosed in the specification, evidence and arguments rebutting the conclusion that such placement was a matter of "design choice" should have been considered as part of the totality of the record. "We have found no cases supporting the position that a patent applicant's evidence or arguments traversing a § 103 rejection must be contained within the specification. There is no

logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of *ex parte* patent prosecution." 66 F.3d at 299, 36 USPQ2d at 1095.) See also *In re Zenith*, 333 F.2d 924, 928, 142 USPQ 158, 161 (CCPA 1964) (evidence that claimed compound minimized side effects of hypotensive activity must be considered because this undisclosed property would inherently flow from disclosed use as tranquilizer); *Ex parte Sasajima*, 212 USPQ 103, 104-05 (Bd.App. 1981) (evidence relating to initially disclosed relative toxicity of claimed pharmaceutical compound must be considered). . . .